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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,979	05/10/2000	THOMAS J. HIGGINS	33-00	4903

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EXAMINER

COLLINS, CYNTHIA E

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/508,979

Applicant(s)

HIGGINS ET AL.

Examiner

Cynthia Collins

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 02 August 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,2,4-6,8,11-57,64,65,67-69,86-94 and 96-115.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: interview summary 08/04


ELIZABETH MCELWAIN
PRIMARY EXAMINER

Continuation of 2. NOTE: the amendment of claim 65 to delete reference to oilseed rape raises new issues that would require further consideration under 35 USC 102 or 103; the amendment of claim 42 to recite plant species not previously recited raises new issues that would require further consideration under 35 USC 102 or 103.

Continuation of 3. Applicant's reply would have overcome the following rejection(s): the rejection of claims 110-115 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for introducing new matter.

Continuation of 5. does NOT place the application in condition for allowance because:

The full scope of claims 1-2, 4-6, 8, 11-57, 64-65, 67-69, 86-94 and 96-115 is not enabled under 35 U.S.C. 112, first paragraph. The specification does not provide sufficient guidance with respect to which sequences other than the sunflower seed albumin coding sequence may be used to modify the content and/or composition of the recited metabolites in any storage organ of any plant; Applicant's proposed claim amendments limiting the claimed method to the seeds of particular plant species would not overcome the rejection because the specification does not provide sufficient guidance with respect to which sequences other than the sunflower seed albumin coding sequence may be used to modify the content and/or composition of the recited metabolites in the seeds of the recited plant species.

The recitation of "modifying" and "modified" in claims 1, 6, 28, 33, 42, 47, 52, 89, 91, 94, 101, 102, 104, 105, 107, 108 and 109 renders the claims indefinite under 35 U.S.C. 112, second paragraph, because the examples set forth in the specification do not limit the terms "modifying" and "modified" set forth in the rejected claims. The claims encompass any and all modifications in the content or composition of any metabolite in any storage organ of any plant; Applicant's proposed amendment of claims 28, 47, 104 and 108 to recite "increasing or decreasing" would overcome the rejection for claims 28, 47, 104 and 108; Applicant's proposed amendment of claims 1, 6, 33, 42, 52, 89, 91, 94, 101, 102, 105, 107 and 109 would not overcome the rejection for these claims because the claims would encompass any and all modifications of the content and/or composition of the recited metabolites in the seed of the recited plant species, and the examples set forth in the specification do not limit the terms "modifying" and "modified" set forth in the rejected claims.

The use of parentheses in claim 65 renders the claim indefinite under 35 U.S.C. 112, second paragraph; Applicant's proposed claim amendment eliminating the use of parentheses would overcome the rejection.

The recitation of "increasing" in claim 103 renders the claim indefinite under 35 U.S.C. 112, second paragraph; Applicant's proposed claim amendment providing a comparative basis for "increasing" would overcome the rejection.

The recitation of "decreasing" in claim 106 renders the claim indefinite under 35 U.S.C. 112, second paragraph; Applicant's proposed claim amendment providing a comparative basis for "decreasing" would overcome the rejection.

The recitation of "increased by at least 8%" in reference to "the total amino acid composition" in claim 111 renders the claim indefinite under 35 U.S.C. 112, second paragraph; Applicant's proposed cancellation of claim 111 would overcome the rejection.

Claims 42-44 and 64 are anticipated under 35 U.S.C. 102(b) by, or in the alternative are obvious under 35 U.S.C. 103(a) over, Molvig et al. (August 1997, Proc. Natl. Acad. Sci. USA, Vol. 94, pages 8393-8398, Applicant's IDS); Applicant's proposed amendment of claim 42 to limit the method to the recited plant species would overcome the rejection under 35 USC 102(b).

Claims 65 and 67-69 are anticipated under 35 U.S.C. 102(b) by Altenbach et al. (Plant Mol Biol. 1992 Jan; 18(2): 235-45, Applicant's IDS). Applicant's proposed amendment of claim 65 to delete reference to oilseed rape would overcome the rejection. Applicant's request for withdrawal of finality of the January 30, 2004 office action on the grounds that no reason was provided as to why the rejection could not have been presented earlier in a nonfinal action is denied. At page 9 of the January 30, 2004 office action it was indicated that Applicant's amendment necessitated the new grounds of rejection presented in the office action. With respect to the rejected claims, in the amendment filed July 29, 2003, filed after the nonfinal office action of January 29, 2003, Applicant amended claims 1 and 21 (from which claim 65 depends) to recite "wherein the sulfur-rich protein is a 2S protein", and Applicant amended claim 65 to recite "oilseed rape". Accordingly, the rejection, directed to oilseed rape transformed with a 2S protein coding sequence, was properly made final in the subsequent office action of January 30, 2004.